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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Paper No.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Scott Andrew Jeffrey

v.

Seung Pil Ahn

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Opposition No. 116,389  
to application Serial No. 75/489298  
filed on May 21, 1998  
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Michelle R. MacGregor of Cowan Liebowitz & Latman, P.C.  
for Scott Andrew Jeffrey.

Seung Pil Ahn, *pro se*.

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Before Wendel, Bucher and Holtzman, Administrative  
Trademark Judges.

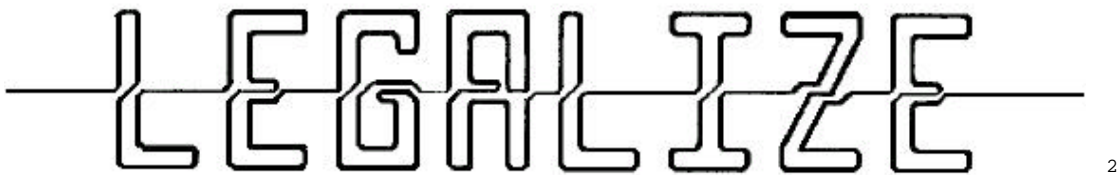
Opinion by Bucher, Administrative Trademark Judge:

Seung Pil Ahn sought to register the term LEGALIZE  
IT for "clothing, namely, caps, beanies, t-shirts,  
shirts, sweaters, jackets and pants," in International  
Class 25.<sup>1</sup> Scott Andrew Jeffrey, a.k.a. "Scotty J.,"

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<sup>1</sup> Application Serial No. 75/489,298, filed May 21, 1998,  
based upon applicant's allegation of a *bona fide* intention to  
use the mark in commerce.

d.b.a. "Legalize," filed an opposition to registration of this term on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act.

As grounds for opposition, opposer has alleged that he has used his "LEGALIZE and design" mark, as shown below:



in connection with T-shirts and hats (or caps), since prior to the filing date of applicant's intent-to-use application; that opposer is the owner of a trademark registration for the same "LEGALIZE and design" mark for "dissemination of advertising for others via an on-line electronic communications network," in International Class 35;<sup>3</sup> that opposer is the owner of a registered collective membership mark LEGALIZE PATRIOT for

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<sup>2</sup> Opposer's literature explains that "The Legalize® trademark represents a sound wave, your own voice saying 'legalize'... The Legalize® trademark can also represent Legalize on the Internet." We note from the front of opposer's caps that this particular design also permits the special form presentation to be sewn with a single, continuous zigzag of an industrial sewing machine, and similarly, that the design also permits a single, continuous neon bulb to represent the mark (see e.g., footnote 7, *infra*).

<sup>3</sup> Reg. No. 2,216,647, issued to Scott Andrew Jeffrey (opposer herein), a.k.a. Scotty J., on December 15, 1998. While this record does not make it clear how Mr. Jeffrey is providing

"indicating membership in an organization dedicated to promoting marijuana legalization and drug policy reform";<sup>4</sup> that the LEGALIZE mark as shown above has been used extensively on the Internet since 1996 to market opposer's goods and services and to promote drug policy reform; that opposer filed an application to register LEGALIZE for clothing items, and that the Trademark Examining Attorney in the LEGALIZE application held up further prosecution of that application<sup>5</sup> based upon the instant, earlier-filed LEGALIZE IT application; and that applicant's mark so resembles opposer's previously used and registered marks that, if used on applicant's goods, confusion is likely.

In his answer, applicant denied the salient allegations in the notice of opposition, taking the position that there is no likelihood of confusion between the marks. Furthermore, applicant also denied that opposer has priority of use.

The record includes the pleadings and the trial testimony deposition of Scott Andrew Jeffrey, with

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advertising services for others under this mark (e.g., like an advertising agency), this issue is not currently before us.

<sup>4</sup> Reg. No. 2,351,547, issued to Scott Andrew Jeffrey (opposer herein), a.k.a. Scotty J., on May 23, 2000.

<sup>5</sup> Application Serial No. 75/632,598, filed on February 7, 1999, based upon an allegation of use in commerce by Scott Andrew Jeffrey since at least as early as April 20, 1997.

exhibits. Other than filing an answer and a response to opposer's first request for production of documents and things, applicant has made no further appearances in this proceeding. Accordingly, only opposer has filed a brief in this case. An oral hearing was not requested.

Mr. Scott Andrew Jeffrey testified that the special form of the mark LEGALIZE, as shown above, has been in use in connection with T-shirts since April 1997; in connection with its advertising services since September 1997; in connection with hats or caps since November 1997; in connection with lighters since 1997; and in connection with bumper stickers since 1998. Mr. Jeffrey further states that opposer has continuously used his special form LEGALIZE mark, as shown above, on all of the listed goods and services since the respective claimed dates of first use.

The testimony and exhibits show that hundreds-of-thousands of people have visited opposer's Web site since late in 1996, and that opposer's LEGALIZE and design mark is used prominently throughout his Web site. Opposer's special form LEGALIZE mark is used on each Web page, in connection with the availability of his newsletters, announcements of special LEGALIZE activities, as well as with the sale of shirts, caps, bumper stickers, lighters

and other products. The testimony also shows that opposer himself has sold T-shirts and caps one at a time in Central Park or to adolescents and young adults exiting a large PC trade show. Over the years, he has also been successful in getting, various merchants in the Village to stock T-shirts, each having his LEGALIZE mark emblazoned across it. Opposer has distributed thousands of 8½" x 11" paper flyers and 3" x 9" bumper stickers ("End the War on America's Youth," "Log On, Tune In, Speak Out!" and "20 Million Stoners Can't Be Wrong") and many promotional business cards, while recording ever-growing numbers of hits on his Web site each year. He and his Legalize organization have appeared in various forms on the "Hemp 100" list in the High Times magazine on four different occasions, making it all the way to the number one spot in April 1999 - according to Scotty J., demonstrating that the editors and readers of High Times magazine considered him the most popular pro-marijuana enterprise in the nation.<sup>6</sup> He and his Legalize organization and Web site were highlighted in a Time magazine article on March 16, 1998.<sup>7</sup> Although the record

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<sup>6</sup> According to opposer's testimony, the Hemp 100 comprises "... cool stoner websites or phrases or ideas." Transcript, p. 55)

<sup>7</sup> This brief article with accompanying pictures refers to opposer's having posted on his Web site a cartoon attempting to

shows that indeed applicant has sold hundreds of shirts and caps since 1997, his tax returns for the years 1997 to 1999 suggest that the expenses that Mr. Jeffrey has written off<sup>8</sup> on his individual income tax returns far exceed the income from the sale of these items of merchandise.

Priority is not in issue in this case. Opposer's two claimed registrations are properly of record,<sup>9</sup> but inasmuch as they are for advertising services and a collective membership mark, it is through opposer's testimony deposition that opposer has demonstrated that he has used his special form LEGALIZE mark in connection with T-shirts and caps since 1997. These dates are prior to the May 21, 1998 filing date of applicant's intent-to-use application, which is his constructive use date.

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parody the well-known Budweiser Frogs. Scotty J's "Our Bud-Is-Wiser" Frogs, are croaking "Lee," "Gull" and "Eyes." These frogs seem to be mesmerized by a flashing, green neon "Legalize" sign atop the near-by tavern at the edge of the swamp. The article noted that counsel for Anheuser-Busch took issue with this usage and wrote to opposer that his client may well be forced to take the necessary legal steps to end this alleged violation of its trademark rights.

<sup>8</sup> His tax write-offs comprised the amalgam of his direct expenses, equipment depreciation, etc., on behalf of his for-profit enterprise, and especially for maintaining his Web site at [www.legalize.com](http://www.legalize.com).

<sup>9</sup> Opposer filed a Notice of Reliance pursuant to Trademark Rule 2.122(d)(2), dated October 6, 2000, with attached status and title copies of opposer's two claimed registrations.

We turn then to the issue of likelihood of confusion. In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors which, if relevant, should be considered in determining likelihood of confusion. In any likelihood of confusion analysis, two key considerations are the similarities of the marks and the relatedness of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ["The fundamental inquiry mandated by Section 2(d) goes to cumulative effect of differences in the essential characteristics of the goods and differences in the marks."]

Considering first the marks, applicant's mark LEGALIZE IT and opposer's mark LEGALIZE, are similar in appearance, pronunciation and connotation. The entirety of opposer's mark is a single word, "Legalize," comprising eight-letters. The identical word, "Legalize," is also the initial portion of applicant's LEGALIZE IT mark. Visually, this long, eight-letter word predominates over the "it" portion of the mark that follows. The three-syllable word "Legalize" sounds very much the same as the four-syllable term "Legalize it."

Certainly as to connotation, the strong, imperative verb "Legalize" demands attention, and even in opposer's mark, implies an object (an "it") of some kind. Accordingly, we find that in every way, these two marks, in their entirety, create the same overall commercial impression.

In finding that the marks are similar, we have kept in mind the normal fallibility of human memory over time and the fact that the average consumer retains a general rather than a specific impression of trademarks encountered in the marketplace. This is especially the case given the inexpensive nature of these goods. Thus, the first du Pont factor weighs against applicant.

Turning next to a consideration of opposer's goods and applicant's goods, we note that applicant and opposer are both using, or intending to use, their respective marks on some of the same items of clothing - namely T-shirts and caps (although variously referred to as "hats," opposer's headwear is a cap having a bill in the front).

Given the identical nature of the goods, we must presume that the goods of both parties will move through identical channels of trade to the same class of purchasers.



In short, given the fact that the marks of the parties create the same commercial impression, and the fact that the goods of the parties are virtually identical, we find that a likelihood of confusion exists.

Decision: The opposition is sustained.